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Paper No. 13
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Intellectual Property/Technology Law

Serial No. 75/808,145

Steven J. Hultquist of Intellectual Property/Technology Law for applicant.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Chapman, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Intellectual Property/Technology Law has filed an application to register PATENT ATTORNEYS AT LAW for "intellectual property legal services."[1]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark is merely descriptive when used in connection with the recited

[1] Serial No. 75/808,145, filed September 24, 1999, claiming a first use date and first use in commerce date of August 19, 1999.

services. Registration has also been finally refused under Sections 1, 2, 3 and 45 of the Trademark Act on the ground that the proposed mark fails to function as a service mark.

The refusals were appealed and both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

Section 2(e)(1) Refusal

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary that the term describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the

term describes one significant attribute thereof. See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

The Examining Attorney maintains that the term PATENT ATTORNEYS AT LAW immediately describes a feature, function, use and purpose of applicant's intellectual property services, in that applicant's services are performed by patent attorneys at law or attorneys at law who specialize in patent law. The Examining Attorney has supported her position with the dictionary definition of "attorney at law" as "an attorney"[2] and by reference to applicant's substitute specimens wherein it is indicated that applicant's services included patent attorney services by such statements as "IPTL is a full service intellectual property firm, providing legal representation in: Acquisition & Enforcement of Proprietary Rights (Patents...)." (Exhibits C & D).

Applicant contends that PATENT ATTORNEYS AT LAW is a suggestive composite mark that is sufficiently incongruous to create a commercial impression distinct from any descriptive components. Applicant argues that its mark is incongruous because it is an odd combination that diverges from general English word formulations and usages.

[2] *The American Heritage Dictionary of the English Language (3rd ed. 1992).*

Applicant states that the term “patent attorney” is generally used to refer to attorneys who specialize in patent law and “attorney at law” is generally used for addressing attorneys with or without specialties. Since patent attorneys are by requirement attorneys at law, the addition of the phrase “at law” is said to be superfluous or redundant on its face. Applicant claims to be the first and exclusive user of the phrase as a mark and that applicant has “therefore coined an incongruous and unconventional phrase, whose facial impropriety attracts immediate attention of prospective clients.” (Supp. Brief p. 4). This impropriety is argued to make applicant’s mark sufficiently distinctive to create an entirely different commercial impression from either “patent attorneys” or “attorneys at law.”

While the combination of descriptive terms may result in a distinctive unitary mark, we do not find that to be true here. The terms “patent attorneys” and “attorneys at law” are both highly descriptive of the persons who perform at least some of applicant’s intellectual property legal services. The combination remains merely descriptive, inasmuch as it has been shown by dictionary definition that an “attorney” may also be called an “attorney at law.”

Whether or not the phrase PATENT ATTORNEYS AT LAW is redundant or superfluous, the descriptive significance of the phrase as used in connection with applicant's services would be immediately apparent to prospective clients. There is no distinctive commercial impression created by the combination as a whole; there is no suggestive, as opposed to descriptive, connotation imparted to the term "patent attorneys" by adding the term "at law." The meaning of the composite phrase remains the same; these services are performed by attorneys at law who specialize in patent law. If we look at the combination from another viewpoint, namely, the addition of "patent" to the term "attorneys at law," the phrase is clearly not redundant or superfluous, in that "patent" adds the name of the specialty of these particular "attorneys at law."

While applicant attempts to draw a parallel here to the situation in In re Delaware Punch Co., 186 USPQ 63 (TTAB 1975) wherein the mark THE SOFT PUNCH was found not to be descriptive for a non-alcoholic soft drink, it is to no avail. As pointed out by the Board in that case, there was a clear double entendre projected by the mark. Such is not the case here. There is but one meaning imparted by PATENT ATTORNEYS AT LAW and that is immediately and highly descriptive of a significant feature or characteristic of

applicant's services, i.e., that they are offered and performed by attorneys at law who specialize in patent law, or in other words, by patent attorneys at law.

Applicant's argument that it is the exclusive user of this term as a mark is equally without merit. As we have often stated, the fact that applicant may be the first and/or the only user of the term for services of this nature is not controlling when the term unquestionably projects a merely descriptive connotation. See In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999).

Accordingly, we find PATENT ATTORNEYS AT LAW merely descriptive when used in connection with applicant's intellectual property legal services.

Section 1, 2, 3, and 45 Refusal

The second issue is whether PATENT ATTORNEYS AT LAW, as used by applicant in connection with its legal services, functions as a service mark to identify and distinguish applicant's services from those of others and to indicate their source. The Examining Attorney maintains that applicant's use of its alleged mark is merely in an informational sense, and thus fails to meet the aforesaid requirements for a service mark. She describes applicant's uses of the term either as a professional designation, as the title of a paragraph describing applicant's

intellectual property legal qualifications, or as a part of other information about applicant such as its address and phone number.

Applicant argues that in its usages of the term, such as in its advertisements (Exhibit D), the "incongruity and distinctiveness" of the mark is sufficient to create a commercial impression separate and apart from the other materials appearing in the advertisement and thus to result in the term functioning as a service mark. Applicant also notes the use of the "SM" designation to evidence the function of this term as a service mark for the services of applicant listed in these advertisements.

Whether or not a term functions as a service mark necessarily depends upon how the term is used and how it is perceived by potential users of the services. To determine what the perception of a term is, we must look to the specimens of record, which show how the term is used in the marketplace. In re Mortgage Bankers Association of America, 226 USPQ 954, 955 (TTAB 1985).

In the advertisement being relied upon by applicant (Exhibit D) the term PATENT ATTORNEYS AT LAW appears as follows:


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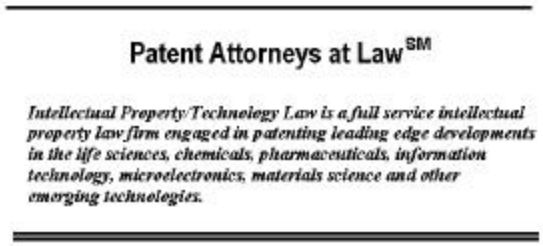
Intellectual Property Technology Law

IPTL is a full service intellectual property law firm, providing legal representation in:

- Acquisition & Enforcement of Proprietary Rights (Patents, Trademarks, Copyrights, Trade Secrets)
- Business Transactions Involving Intellectual Property
- Licensing & Technology Transfer
- Intellectual Property Audits
- Set-Up & Management of Intellectual Property Administration Programs
- Resident (Periodic/Temporary) Counsel Services
- Intellectual Property Valuations
- Infringement Assessment & Design-Around Efforts

Patent Attorneys at Law℠ - www.iptl.com
6320 Quadrangle Drive, Suite 110 - Chapel Hill, NC 27514
919-419-8350 - fax: 919-419-8354
Patenting Technology at the Leading Edge℠

Other specimens include newsletters of applicant (Exhibits A and B) which shows usage of the term in the following manner:


Patent Attorneys at Law℠

Intellectual Property/Technology Law is a full service intellectual property law firm engaged in patenting leading edge developments in the life sciences, chemicals, pharmaceuticals, information technology, microelectronics, materials science and other emerging technologies.

We are in agreement with the Examining Attorney that such usages of the term would be perceived by potential clients as being purely informational in nature. In the advertisement, the many intellectual services are listed as being offered by the firm of IPTL (applicant); this is the source of the services. The term “Patent Attorneys at Law”

merely conveys information as to the professional capacity of the persons in the firm. The fact that the "SM" designation is displayed next to the term cannot in itself create the commercial impression that the term is being used as a mark identifying applicant's services and distinguishing them from those of others. See In re B.C. Switzer & Co., 211 USPQ 644 (TTAB 1981). The only usage which would be evident to potential clients would be as an indicator of the titles of the persons performing these services. As we have discussed above, there is no non-descriptive significance to the term which would raise it above being purely informational in nature.

In the newsletters of applicant the term serves an equally informational purpose, indicating the nature of the persons who comprise the "full service intellectual property law firm" identified by applicant's name, Intellectual Property/Technology Law.

Accordingly, we find that the term PATENT ATTORNEYS AT LAW as used by applicant in connection with its services fails to function as a service mark to identify and distinguish applicant's services from those of others and to indicate their source.

Decision: The refusals to register under Section 2(e)(1) and Sections 1, 2, 3, and 45 are affirmed.